

REMARKS

The undersigned thanks Examiner Rodriguez for the courtesies extended during the telephone interview of September 15, 2006.

Claims 1-8 were rejected for the same invention double patenting over claims 1-8 of U.S. Patent No. 6,774,333. Claims 1-8 were rejected for obviousness-type double patenting over claims 8-12 of U.S. Patent No. 6,974,927. This rejection should be withdrawn as claims 1-8 have been canceled.

Claims 9-18 were rejected for the same invention double patenting over claims 1-10 of U.S. Patent No. 6,835,911. This rejection should be withdrawn as claims 9-18 have been canceled.

Claims 9-13 and 16-18 were rejected as being anticipated by Kuhr. Claims 14 and 15 were rejected as being obvious over Kuhr.

As explained to Examiner Rodriguez during the interview, claims 9-18 are identical to claims 1-10 of U.S. Patent No. 6,835,911, which were allowed by Examiner Heinrich *after considering Kuhr*. Examiner Rodriguez explained that Examiner Heinrich might have failed to consider the functional limitation regarding the material or article worked on and thus might have allowed these claims. The undersigned explained that claims 9 and 16 recite “a light source tuned substantially to a resonant condition, the resonant condition corresponding to a target class of carbon nanotubes” while the light source of Kuhr is tuned to a resonant condition corresponding to a single cesium atom. After all, a carbon nanotube is many times larger than a single cesium atom, and different in size than a single cesium atom. Thus, the light source of Kuhr would *not* necessarily be capable of being tuned to carbon nanotube—for example, the power and wavelength of the light source required for the resonant condition corresponding to a target class of carbon nanotubes would be totally different from that required for the resonant condition corresponding to a single cesium atom—and there is no evidence to the contrary in Kuhr. Thus, Examiner Heinrich’s judgment to grant claims 1-10 of U.S. Patent No. 6,835,911 is correct.

As stated in 35 USC 282, “A patent shall be presumed valid.” The presumption of validity means that the USPTO cannot substitute its judgment for the judgment of the examiner after a patent has been granted *unless* there is a request for reexamination “in writing” (35 USC 302)¹ that raises a “substantial new question of patentability” (35 USC 304) by citing “patents or printed publications” (35 USC 301) that were *not* considered by the examiner (MPEP 2242IIA), such that the reexamination would establish that the examiner was wrong. Applicants respectfully submit that claims 1-10 of U.S. Patent No. 6,835,911, which were allowed by Examiner Heinrich after considering the *same* Kuhr reference, are presumed valid under the law. Furthermore, the *same* Kuhr reference does *not* raise a “substantial new question of patentability” as explained in MPEP 2242IIA: “A ‘substantial new question of patentability’ is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).” [Underlining in original.] Therefore, claims 1-10 of U.S. Patent No. 6,835,911 are presumed valid.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

¹ MPEP 2244 explains, “The Director of the USPTO has the authority to order reexamination only in those cases which raise a substantial new question of patentability. The substantial new question of patentability requirement protects patentees from having to respond to, or participate in unjustified reexaminations. See, e.g., *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985).”

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 070702006210.

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Respectfully submitted,

By 

Raj S. Dave'

Registration No.: 42,465

MORRISON & FOERSTER LLP

1650 Tysons Blvd, Suite 300

McLean, Virginia 22102

(703) 760-7755